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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,450	12/20/2005	Masayoshi Handa	1422-0702PUS1	6369
2292 7590 09/04/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER BUIE, NICOLE M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/04/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

**Application No.**

10/561,450

**Applicant(s)**

HANDA ET AL.

**Examiner**

NICOLE M. BUIE

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 20051220/20060320/20080331
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 07/11/2003. It is noted, however, that applicant has not filed a certified copy of the 2003-273507 application as required by 35 U.S.C. 119(b).

### ***Information Disclosure Statement***

The following documents, JP 63-118375A, JP 01-210463A, JP 63-146964, JP 63-272349A, JP 08-052203A, JP 2004-21924A, JP2003-206305A, JP2003-206381A, JP 2000-026738A, cited in the information disclosure statement 03/20/2006 have been already submitted and considered as part of the information disclosure statement filed on 12/20/2005.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Obayashi et al. (US 4,863,989) in view of Hosokawa et al. (US 2001/0053826).

**Regarding claims 1, 3, 5, 6, and 7**, Obayashi et al. discloses a water-absorbent resin composition (Abstract, C1/L5-12) comprising a water-absorbent resin (C2/L47-57), an oxygen-containing reducing inorganic salt (i.e. sulfites, bisulfites, pyrosulfites, dithionites, and nitrites) (C2/L63-C3/L18), and an organic antioxidant (i.e. ascorbic acids, gallic acids, and benzimidazoles) (C3/L42-68).

However, Obayashi et al. does not disclose an aminocarboxylic acid-based metal chelating agent. Hosokawa et al. teaches aminocarboxylic acid compounds (i.e. ethylenediaminetetracetic acid, hydroxyethylenediaminetriacetic acid, diethylenetriaminepentaacetic acid, triethylenetetraminehexaacetic acid, and salts thereof) [0071]. (The chelating agent of Hosokawa et al. is able to chelate with zinc salts as evidenced by Hosakawa [0052]) in a water-absorbent composition.) Hosokawa et al. further teaches the amount of aminocarboxylic acid-based metal chelating agent is 0.01 to 5 parts by weight per 100 parts by weight of a water-absorbent resin[0081]. Obayashi et al. and Hosokawa et al. are analogous art concerned with the same field of endeavor, namely water-absorbent resin compositions. It would have been obvious to one of ordinary skill in the art at the time of invention to use an aminocarboxylic acid-based compound of Hosokawa et al. in a composition

of Obayashi et al., and the motivation to do so would have been as Hosokawa et al. suggests improving gel stability of a water-absorbent resin composition [0082].

**Regarding claim 2**, Obayashi et al. discloses a water-absorbent resin composition wherein the amount of the oxygen-containing reducing inorganic salt is 0.01 to 5 parts by weight based on 100 parts by weight of the water-absorbent resin (C3/L19-31).

**Regarding claim 4**, Obayashi et al. discloses a water-absorbent resin composition wherein the amount of the organic antioxidant is 0.001 to 5 parts by weight based on 100 parts by weight of the water-absorbent resin (C4/L1-4).

**Claims 8 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Obayashi et al. (US 4,863,989) in view of Hosokawa et al. (US 2001/0053826) as applied to claim 1 above, further in view of Wada et al. (US 5,760,080) as evidenced by Torrii et al. (US 2003/0069359 A1).

**Regarding claim 8**, modified Obayashi et al. discloses a water-absorbent resin composition as shown above in claim 1. Obayashi et al. further discloses an absorbent (C4/L29-32).

However, Obayashi et al. does not disclose a hydrophilic fiber. Wada et al. teaches hydrophilic fibers for an absorbent (C5/L11-16). Modified Obayashi et al. and Wada et al. are analogous art concerned with the same field of endeavor, namely water-absorbent compositions. It would have been obvious to one of ordinary skill in the art at the time of invention to use hydrophilic fibers of Wada et al. in a composition of modified Obayashi et al., and the motivation to do so would have been as Torrii et al. suggests absorbing water in a short time of

an absorbent, retaining swollen water-absorbent resins after water is absorbed, or sufficiently spreading water to the water-absorbent resins that are distributed according to capillary action, retaining powdery absorbent-resins [0005].

**Regarding claim 9**, Obayashi et al. discloses an absorbent article (C4/L29-32).

However, modified Obayashi et al. does not disclose an absorbent article interposed between a liquid-permeable sheet and a liquid-impermeable sheet. Wada et al. teaches an absorbent article interposed between a liquid-permeable sheet and a liquid-impermeable sheet (C18/L11-25). Modified Obayashi et al. and Wada et al. are analogous art concerned with the same field of endeavor, namely water-absorbent resin compositions. It would have been obvious to one of ordinary skill in the art at the time of invention to interpose between a liquid-permeable sheet and a liquid-impermeable sheet of Wada et al. in an article of modified Obayashi et al., and the motivation to do so would have been as Wada et al. suggests to achieve excellent water absorbing properties (C18/L11-25).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-7** are directed to an invention not patentably distinct from claims 1, 5, and 6 of commonly assigned 10/552,152.

**Claims 1-7** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, and 6 of copending Application No. 10/552,152 in view of Obayashi et al. (US 4,863,989).

Application '152 recites a water-absorbent resin composition a water-absorbing resin which comprises a water-absorbing resin, a metal chelating agent, such as an aminocarboxylic acid metal chelating agent (i.e. ethylenediaminetetraacetic acid, diethylenetriaminepentaacetic acid, triethylenetetraminehexaacetic acid, and salts thereof) (claims, 1, 5, and 6).

However, Application '152 does not recite an oxygen-containing reducing inorganic salt. Obayashi et al. teaches the amount of the oxygen-containing reducing inorganic salt (i.e. sulfites, bisulfites, pyrosulfites dithionites, and nitrites) is 0.01 to 5 parts by weight based on 100 parts by weight of the water-absorbent resin (C2/L63-67C3/L19-22). Application '772 and Obayashi et al. are analogous art concerned with the same field of endeavor, namely water-absorbent resin compositions. It would have been obvious to one of ordinary skill in the art at the time of invention to use the amount of oxygen-reducing inorganic salt of Obayashi et al. in Application '772, and the motivation to do so would have been as Obayashi et al. suggests improvement of gel stability (C3/L19-27).

However, Application '152 does not recite the an organic antioxidant. Additionally, Obayashi et al. teaches the amount of the organic antioxidant (i.e. ascorbic acid, gallic acid, and benzimidazoles) is 0.001 to 5 parts by weight based on 100 parts by weight of the water-absorbent resin (C4/L1-4). It would have been obvious to one of ordinary skill in the art at the time of invention to use the amount of oxygen-reducing inorganic salt of Obayashi et al. in Application '772, and the motivation to do so would have been as Obayashi et al. suggests improvement of gel stability (C4/L4-10).

This is a provisional obviousness-type double patenting rejection.

#### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo, Ph.D./  
Supervisory Patent Examiner, Art Unit 1796  
1-Sep-08

/N. M. B./  
Examiner, Art Unit 1796  
8/27/2008